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D-1112 R4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of **Jeffery Enright**	)	Art Unit 3691
Application No.: **09/991,748**	)	
Confirmation No.: **7030**	)	Patent Examiner Frantzy Poinvil
Filed: **November 23, 2001**	)	
Title: **Automated Banking Machine System and Method**	)	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

PETITION FROM ACTIONS OF THE BOARD OF PATENT APPEALS AND INTERFERENCES

This petition is the result of the Board of Patent Appeals and Interferences ("Board") making errors which resulted in the Board relying on erroneous opinions in rendering the Decision on Request for Rehearing dated September 23, 2010 ("Decision"). The Decision was in response to Appellant's Request for Rehearing filed November 23, 2009 regarding the decision dated September 22, 2009 in Appeal No. 2008-004397.

As a result of the critical procedural errors and the critical errors of fact made by the Board, Appellant petitions to have grounds of rejection set forth in the Decision be designated as new grounds of rejection, and to have all claim rejections vacated and reversed.

Kindly enter Appellant's following remarks without prejudice.

PAGE 3/9 * RCVD AT 10/30/2010 12:21:07 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/44 * DNIS:2738300 * CSID:3307226446 * DURATION (mm-ss):02-30

The Board did not apply the correct legal standard for review

The record shows that the Board applied at least one different ground of rejection without designating the different ground rejection as a new ground of rejection.

The Applicable Legal Standards

In re Kronig, 539 F.2d 1300, 1302; 190 USPQ 425, 426 (CCPA 1976)

> The "ultimate criterion" of whether a rejection is new is "whether appellants have had fair opportunity to react to the thrust of the rejection."

In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970)

> "Where a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of rejection."

Ex parte Zhang, BPAI Appeal No. 2009-6959, pg. 4 n.2

> "The Examiner relies upon additional references in support of that argument . . . Because those references are not included in the statement of the rejection, they are not properly before us . . . Accordingly, we have not considered those references in reaching our decision."

Ex parte Kamboj, BPAI Appeal No. 2000-1779, pg. 89 n.64

> "we remind the examiner that 'where a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of the rejection."

Ex parte Sabathie, BPAI Appeal No. 2000-1332, pg. 8 n.1

> "Where a reference is relied on to support a rejection, whether or not in a minor capacity, there is no excuse for not positively including the reference in the statement of the rejection."

PAGE 4/9 * RCVD AT 10/30/2010 12:21:07 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/44 * DNIS:2738300 * CSID:3307226446 * DURATION (mm-ss):02-30

Ex parte Michael, BPAI Appeal No. 1997-0752, pg. 3-4

> "If a prior art teaching is relied upon in any capacity to support a rejection, it should be positively included in the statement of the rejection."

Ex parte Raske, 28 USPQ2d 1304-05 (BPAI 1993)

> "We therefore view the reference to Raviola and Mitsui, at page 4 of the Answer, as an improper effort to bring these references in the "back door." Compare In re Hoch, 428 F.2d 1341, 1342 n. 3, 166 USPQ 406, 407 n. 3 (CCPA 1970) . . . Raviola and Mitsui are not positively included in the statement of rejection, and we have considered the issue under 35 USC 103 based solely on the evidence contained in Ishikawa and Billmeyer."

USPTO Patent Bar Exam, October 15, 2003, afternoon session, question #42

Question: "The primary examiner has rejected claims 1-10 under 35 USC 103(a) as being unpatentable over the Smith patent in view of the Jones reference. Appellant properly argues that there is no motivation to combine the teachings of Smith and Jones. The examiner repeats the rejection of claims 1-10 as being "unpatentable over Smith in view of Jones." The examiner additionally cites a patent to Brown that was necessary to provide motivation for combining the teachings of Smith and Jones. The examiner does not list Brown in the statement of the rejection. Appellant timely appeals to the Board of Patent Appeals and Interferences, and files a proper appeal brief. The examiner files an examiner's answer addressing the rejection of claims 1-10 under 35 USC 103(a) as being unpatentable over Smith in view of Jones, and cites Brown in the argument as providing motivation to combine Smith and Jones. In accordance with the patent laws, rules and procedures as related in the MPEP, what will be the most proper decision of the Board?"

PAGE 5/9 * RCVD AT 10/30/2010 12:21:07 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/44 * DNIS:2738300 * CSID:3307226446 * DURATION (mm-ss):02-30

Answer: "If the claimed invention is rendered obvious by Smith in view of Jones and Brown, the statement of rejection must include all three references. Reliance on Brown to support the rejection is a different rejection from a rejection relying only on Smith in view of Jones. In accordance with MPEP § 1208.01, the Board will not consider the teachings of Brown because Brown was used to support the rejection, but was not listed in the statement of the rejection. As stated in MPEP § 1208.01, 'Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection. *In re Hoch* . . . The decision cannot affirm the rejection since there is no motivation for combining the teachings of Smith and Jones absent the teachings of Brown. Therefore, the rejection must be reversed, not affirmed."

The Board's reliance on a new reference in the Decision was legally improper

The record show that the Decision (at page 21) relies on *Webster's New World Dictionary* (1988) for both "correspond" and "correlate." The Decision (at pages 22 and 24) also relies on *Webster's New World Dictionary, 3rd College Edition* (1988) for both "ask" and "link." (It is unclear whether these dictionaries are the same dictionary). However, no *Webster's New World Dictionary* was of record at the time of appeal.

The facts of record show that the Board entered, considered, and applied new evidence (e.g., a dictionary and definitions therefrom) in rendering the Decision. Thus, the Decision relies on at least one new reference (e.g., the dictionary) that was previously not of record. Appellant respectfully submits that the Decision's reliance on this new reference constitutes a new ground of rejection.

PAGE 6/9 * RCVD AT 10/30/2010 12:21:07 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/44 * DNIS:2738300 * CSID:3307226446 * DURATION (mm-ss):02-30

The "ultimate criterion of whether a rejection is considered "new" is whether the Appellant has "had fair opportunity to react to the thrust of the rejection" (*In re Kronig*, at USPQ 426). Therefore, a question to be answered in deciding this petition is: was a new reference part of the evidence considered by the Board in rendering the Decision? If so, then the finality of the Decision was legally improper because prosecution closure prevented Appellant from having fair opportunity to react to the new thrust of rejection.

Appellant respectfully submits that the record shows that a new reference (*Webster's New World Dictionary*) was indeed part of the evidence considered (and relied on) by the Board in rendering the Decision. The record does not support a conclusion that the Decision did not rely in any way on this new reference.

Appellant has not been given fair opportunity (in accordance with 37 C.F.R. 1.111) to properly rebut the Board's newly imposed basis for rejection. For example, Appellant has not been provided fair opportunity to present evidence that the new reference's definitions relied upon in the Decision either are inaccurate or are not the most germane definitions to the person of ordinary skill in the art at the time of the invention. The Office is committing prejudicial error by depriving Appellant of his administrative due process rights (e.g., timely notice of the Office's position and opportunity for unhindered response thereto).

The Board erred in the Decision by not designating as new grounds of rejection, all grounds of rejection which rely on the newly applied *Webster's New World Dictionary*. Appellant respectfully requests grant of his petition to have these grounds of rejection in the Decision be designated as new grounds of rejection.

PAGE 7/9 * RCVD AT 10/30/2010 12:21:07 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/44 * DNIS:2738300 * CSID:3307226446 * DURATION (mm-ss):02-30

The Board's reliance on a new definition for "electronic signature" was legally improper

The facts of record show that the Board entered, considered, and applied a new definition for "electronic signature" in rendering the Decision. The record shows that the definition for "electronic signature" applied in the Decision differs from the definition applied in the initial decision dated September 22, 2009. The Board's switching of definitions is legally improper.

Definition for "electronic signature" as used in the initial decision

> "an electronic sound, symbol, or process attached to or associated with a contract or other record and used as the legal equivalent of a written signature" (Finding of Fact 3).

Definition for "electronic signature" as used in the Decision

> "an electronic sound, symbol, or process, attached to or logically associated with a contract or other record and executed or adopted by a person with the intent to sign the record" (Decision at page 8, lines 12-18).

The Board's reliance on this new (and substantively different) definition for "electronic signature" in the Decision constitutes a new ground of rejection. Appellant has not "had fair opportunity to react to the thrust of the rejection" (*In re Kronig*, at USPQ 426). Appellant has not had fair opportunity to properly rebut the newly imposed basis for rejection. Again, the Office is committing prejudicial error by depriving Appellant of his due process rights (e.g., timely notice of the Office's position and opportunity for unhindered response thereto).

The Board's act may also violate the fundamental legal principle that an administrative agency may not avoid review of its actions by engaging in repetitive activity (e.g., switching definitions) which does not remain in place long enough to enable judicial review. *Southern Pacific Terminal Co. v. Interstate Commerce Com.*, 219 U.S. 498, 55 L.Ed. 310, 31 S. Cr. 279 (1911).

PAGE 8/9 * RCVD AT 10/30/2010 12:21:07 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/44 * DNIS:2738300 * CSID:3307226446 * DURATION (mm-ss):02-30

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Furthermore, even if Appellant could have somehow read the Board's mind to have based his Request for Rehearing on the Board's newly applied definition for "electronic signature", the Board would have likely disregarded his arguments related thereto as not being pertinent to the definition applied in the initial decision. The Board can't have it both ways.

All rejected claims include "electronic signature." Thus, all grounds of rejection in the Decision rely on the Board's newly applied definition for "electronic signature." The Board erred in the Decision by not designating all grounds of rejection as new grounds of rejection. Appellant respectfully requests grant of his petition to have all grounds of rejection in the Decision be designated as new grounds of rejection.

Conclusion

Appellant's petition should be granted for the reasons presented herein. The undersigned is willing to discuss any aspect of the petition by telephone at the Office's convenience.

Respectfully submitted,



Ralph E. Jocke Reg. No. 31,029
Daniel D. Wasil Reg. No. 45,303
WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256

Customer No. 28995
(330) 721-0000

PAGE 9/9 * RCVD AT 10/30/2010 12:21:07 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/44 * DNIS:2738300 * CSID:3307226446 * DURATION (mm-ss):02-30